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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,527	02/28/2002	Gebhard Dopfer	99P03591US	9801

7590 03/21/2007  
SIEMENS CORPORATION  
INTELLECTUAL PROPERTY DEPT.  
186 WOOD AVENUE SOUTH  
ISELIN, NJ 08830

EXAMINER
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JOLLEY, KIRSTEN

ART UNIT	PAPER NUMBER
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1762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/085,527

**Applicant(s)**

DOPPER, GEBHARD

**Examiner**

Kirsten C. Jolley

**Art Unit**

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12,13,18,19 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12,13,18,19 and 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's filing of a certified copy of the foreign priority application is noted.

#### ***Election/Restriction***

2. Newly submitted claim 30 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 30 is directed to a method for the surface preparation of a component which requires the formation of a surface roughness according to a predetermined non-constant function along the component's contour line. Claim 30 is directed to a different invention than the originally presented invention (claims 1, 3-10, 12-13, 18-19, and 21-29) directed to a method for the surface preparation of a component comprising forming a uniform or homogeneous surface roughness along the component's contour line. These inventions are not capable of use together, have a materially different design, mode of operation, function, or effect, do not overlap in scope (i.e., are mutually exclusive), and are not obvious variants.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 30 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Response to Arguments***

3. The 35 USC 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph rejections have been withdrawn in response to Applicant's amendments to the claims.
4. Applicant's arguments filed December 20, 2006 have been considered but are not persuasive.

Applicant argues that McComas specifically teaches that blasting angle is not a critical parameter, but is simply a matter of preference. This is not convincing to the Examiner. While McComas does state that the angle between the jet and the coating is not a critical parameter and is a matter of preference, McComas is referring to *the angle used* – not that the angle is not maintained constant or is movable during the abrading process. It is the Examiner's position that, to the contrary, col. 3, lines 9-21 imply that a constant blasting angle is used since the paragraph discloses merely setting a single angle, and the angle used affects fragment location post-removal.

Applicant also argues that Taylor reinforces the lack of importance of blast angle by requiring that only the jet pressure and nozzle traverse rate must be carefully controlled. The Examiner disagrees. Taylor does not reinforce the lack of importance of blast angle. To the contrary, Taylor states that jet pressure must be carefully controlled. An engineer having ordinary skill in the art would have recognized that the angle of blasting/waterjet directly affects jet pressure. An angle that is 90 degrees to the surface would impact the surface with a different, higher pressure than a jet having an acute angle between the jet and substrate surface. (The "head on" 90 degree angle jet means that the entire diameter of the jet stream hits the surface from the same, smallest distance, whereas an acute-angled jet hits the surface such that some of

Art Unit: 1762

the jet stream hits from a larger distance where some of the jet stream hits from a smaller distance.)

Applicant states that Kaiba teaches away from maintaining a constant blasting angle.

While Kaiba does not teach a constant blasting angle, the reference is used to illustrate the use of automatic systems to perform painting and/or grit blasting.

The Examiner maintains the position set forth in the prior Office action that it would have been well within the skill of an ordinary artisan to maintain a constant blasting angle during grit blasting. As discussed above, the angle of blasting directly affects the amount of blasting at any one location. In the case where a uniform, homogeneous surface roughness is desired, it would have been obvious to one having ordinary skill in the art to have maintained a constant blasting angle, or else non-uniformity in surface roughness would result. Additionally, it is noted that McComas et al. teaches that the blasting angle affects the fragment location post-blasting, and the direction helps to remove the fragments from the interaction zone thereby ensuring that they do not interfere with the blasting process (col. 3, lines 18-22). It would have been obvious to one having ordinary skill in the art to have maintained the blasting angle constant in order to consistently remove the blasted fragments from the interaction zone to similar locations since changing the angle would cause the fragments to move in a different location and thus potentially interfere with the blasting/abrading process.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1762

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-10, 12-13, 18-19, and 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (US 5,520,516) alone or in view of McComas et al. (US Re. 35,611), and further in view of Kaiba et al. (US 6,096,132).

The claims remain rejected for the reasons discussed in the prior Office action, as well as for the reasons discussed above in section 4.

With respect to new claim 29, Taylor et al. does not teach grit blasting at least two surfaces of a component to produce different surface roughnesses. It is the Examiner's position that it would have been well within the skill of an ordinary artisan to have performed the process of Taylor et al. taken alone or in view of McComas et al., and further in view of Kaiba et al., on more than one component surface with the expectation of successful results since such is merely duplication of an obvious process. It is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 124 USPQ 378 (CCPA 1960). The desirability of different surface roughnesses on different surfaces would be a matter of design choice depending upon the features and types of coatings subsequently applied to the different surfaces.

### ***Conclusion***

Art Unit: 1762

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Kirsten C Jolley  
Primary Examiner  
Art Unit 1762

kcj